

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 5-28-03

APPL. S.N.: 091,734,801

TO EXAMINER: S. Chunduru

ART UNIT: 1637

MOSE MONTGOMERY ROOM 4E18

MAILROOM DATE 5-21-03

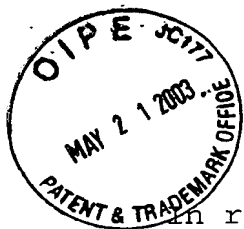
AFTER FINAL YES ☐ NO ☒ NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this Informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

- ☒ The T.D. is PROPER and has been recorded. (See 14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).
- ☐ The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)
- ☐ Application Examiner has not processed T.D. fee. (See fee authorization).
- ☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).
- ☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).
- ☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).
- ☐ The person who signed the terminal disclaimer:
☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).
☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).
- ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).
- ☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).
- ☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.
- ☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).
- ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).
- ☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).
- ☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)
- ☐ Other: _____
- ☐ Suggestion to request refund of \$ _____. (See 14.35, 14.36).
- ☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP**

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

- ☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).
- ☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).
- ☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of) Examiner: CHUNDURU, S.
)
Roland Carlsson et al.) Art Unit: 1637
)
Serial No.: 09/734,801) Response to Paper No. 16
)
Filed: December 12, 2000)
)
For: "A METHOD FOR IN VITRO)
MOLECULAR REVOLUTION OF)
PROTEIN FUNCTION")

TERMINAL DISCLAIMER RESPONSIVE TO

OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

The above-identified patent application (hereinafter "the '801 application") is owned by the BioInvent International AB, Sweden (hereinafter "Assignee").

Assignee, by its undersigned agent, who is agent of record in the '801 application, hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the '801 application which would extend beyond the expiration date of the full statutory term, as defined in 35 U.S.C. §§ 154 to 156 and 173, as presently shortened by any terminal disclaimer, of U.S. Patent No. 6,159,690, issued December 12, 2000 on U.S. Application No. 09/098,287, of which Assignee is the owner of all right, title and interest.

Assignee, by its undersigned agent, hereby agrees that any patent so granted on the '801 application shall be enforceable only for and during such period that the legal title to such patent shall be the same as the legal title to said U.S. Patent No. 6,159,690, this agreement to run with any patent granted on the '801 application and to be binding upon the grantee, its successors or assigns.

In making the foregoing disclaimer, Assignee does not disclaim the terminal part of any patent granted on the '801 application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and

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173 of U.S. Patent No. 6,159,690, as presently shortened by any terminal disclaimer filed prior to patent grant, in the event that U.S. Patent No. 6,159,690: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321, has all claims canceled by a reexamination certificate, is reissued or is in any manner terminated prior to expiration of its full statutory term as presently or subsequently shortened by any terminal disclaimer, as the case may be, except for the separation of legal title stated above.

A check for \$110.00 is enclosed herewith to cover the statutory disclaimer fee. The Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 04-1406.

Respectfully submitted,

DANN, DORFMAN, HERRELL AND SKILLMAN
A Professional Corporation

By


Kathleen D. Rigaut, Ph.D., J.D.
PTO Registration No. 43,047

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